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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,724	07/28/2003	Timothy Effrem	MAS001	3513

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THE LAW OFFICES OF ROUZ TABADDOR, ESQ.
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WASHINGTON, DC 20006

EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/627,724

Applicant(s) 

EFFREM, TIMOTHY

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 13 and 20-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims a chuck effective capacity of "about 5 mm to above". The claimed range is indeterminable since Applicant's own specification does not clearly enable the claimed limitation. Specifically on page 2 in the section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of 0-6.35 mm and again on page 3 in the same section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of "up to at least 6.35 mm". As a result, it has been determined that the specification does not enable the claimed limitation to extend to an infinite range above 6.35 mm as the claims now permit.

Furthermore, Applicant's proposed amendment filed 10 January 2007 to the specification to include the following: "In another embodiment, the chuck jaws may be adjusted by a chuck key and the chuck has an effective capacity of about 5 mm to above" adds further confusion to the already submitted specification (see above paragraph for examples) which clearly state a completely different range for the chuck effective capacity. This further supports the fact that the claim(s) contains subject matter which was not described in the specification in

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such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. In addition, it has been determined that the chuck effective capacity range of 0-6.35 mm disclosed on page 2, lines 4 through 5, in the section entitled "Summary of the Invention" renders a "lack of criticality" since the range incorporates the possibility of a "0" capacity.

4. In addition, the specification on page 6, lines 2-3 states: "the second portion B has a diameter D which is less than the diameter of the first portion." However the ranges recited within independent claims 13 (first portion: 25.5 mm to 27.0 mm and second portion: 25.2 mm and 25.6 mm) and 20 (first portion: 25.5 mm to above and second portion: 25.2 mm and 25.6 mm), permits for the first portion to have a diameter less than that of the second portion which is not supported by the original disclosed specification and figures. Again, this further supports the fact that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claims 13 and 20-30, the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims a chuck effective capacity of "about 5 mm to above". The claimed range is

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indeterminable since Applicant's own specification does not clearly enable the claimed limitation. Specifically on page 2 in the section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of 0-6.35 mm and again on page 3 in the same section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of "up to at least 6.35 mm". As a result, it has been determined that the specification does not enable the claimed limitation to extend to an infinite range above 6.35 mm as the claims now permit.

Furthermore, Applicant's proposed amendment filed 10 January 2007 to the specification to include the following: "In another embodiment, the chuck jaws may be adjusted by a chuck key and the chuck has an effective capacity of about 5 mm to above" adds further confusion to the already submitted specification (see above paragraph for examples) which clearly state a completely different range for the chuck effective capacity. This further supports the fact that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

8. In addition, the specification on page 6, lines 2-3 states: "the second portion B has a diameter D which is less than the diameter of the first portion." However the ranges recited within independent claims 13 (first portion: 25.5 mm to 27.0 mm and second portion: 25.2 mm and 25.6 mm) and 20 (first portion: 25.5 mm to above and second portion: 25.2 mm and 25.6 mm), permits for the first portion to have a diameter less than that of the second portion which is not supported by the original disclosed specification and figures. Again, this further supports the fact that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9. Regarding claim 20, the phrase "a diameter in the range of about 25 mm to above" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

10. Regarding claim 20, the phrase "a diameter in the range of about 25.2 mm to about 25.6 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall diameter. See MPEP § 2173.05(b).

11. Regarding claim 21, the phrase "the length of the first portion is in the range of about 35 mm to about 45 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the first portion shrouded wall length. See MPEP § 2173.05(b).

12. Regarding claim 22, the phrase "the length of the first portion is about 40 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the first portion shrouded wall length. See MPEP § 2173.05(b).

13. Regarding claim 23, the phrase "the diameter of the first portion is about 26 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

14. Regarding claim 24, the phrase "the thickness of the shrouded wall is in the range of about 0.7 mm to about 1.2 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the shrouded wall thickness. See MPEP § 2173.05(b).

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15. Regarding claim 25, the phrase "the thickness of the shrouded wall is about 0.7 mm - 0.8 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the shrouded wall thickness. See MPEP § 2173.05(b).

16. Regarding claim 27, the phrase "the second portion has a length in the range of about 40 mm to about 85 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall length. See MPEP § 2173.05(b).

17. Regarding claim 28, the phrase "the second portion has a length of about 62 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall length. See MPEP § 2173.05(b).

18. Regarding claim 29, the phrase "the second portion has a diameter of about 25.4 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall diameter. See MPEP § 2173.05(b).

Allowable Subject Matter

19. Patentability of claims 13 and 20-30 can not be determined at this time due to the rejection(s) under 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph set forth in this Office action.

Response to Arguments

20. Applicant's arguments, see page 1, 3rd full paragraph, filed 10 January 2007, with respect to claims 13 and 20-30 with respect to the rejection(s) under 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph with regards to the introduction of new matter have

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been fully considered and are persuasive. The rejection of claims 13 and 20-30 under 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph with regards to the introduction of new matter into the disclosure has been withdrawn.

21. Applicant's arguments filed 10 January 2007 have been fully considered but they are not persuasive.

22. The application is filled with 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph issues that must be addressed and resolved prior to further prosecution of the claims based upon the merits.

23. Examiner respectfully disagrees with Applicant's assertion regarding the terms "greater than" or "less than" being equivalent to the "about 25 mm to above". The terms "greater than" or "less than" do set forth the metes and bounds for patent protection (i.e. greater than 25 mm) since one would know that the value must be any value higher than 25 mm. But when using "about 25 mm", one does not know the metes and bounds since the value could be anywhere close to 25 mm, including values that lie above or below 25 mm (i.e. 23.8 or 26.9). It is not clearly defined and therefore a rejection under 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph is proper.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT
Examiner
16 March 2007



MONICA CARTER
SUPERVISORY PATENT EXAMINER